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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,243	01/05/2001	Rudolfus A.T.M. Van Benthem	P 275922 9637US/CONT	3640

909            7590            12/24/2002  
PILLSBURY WINTHROP, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

[REDACTED] EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
1711	15

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/754,243	VAN BENTHEM ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Susan W Berman	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 July 2002 and 11 September 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2,3 and 9-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2,3,9-21,24 and 26 is/are rejected.
- 7) Claim(s) 22,23,25 and 27 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Terminal Disclaimer***

The terminal disclaimer filed on 07-17-2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,245,829 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 18, 22-25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (1) There is no antecedent basis in claim 2 or in claim 26 for the recitation “Composition according to claim 2 (or claim 26)” in each of claims 22-25 and 27. Claims 2 and 26 only recite a “radiation curable compound”. If applicant intends to claim the “compound” of the formula set forth in claim 2 or in claim 26, it should be so stated. If applicant intends to claim a “composition” comprising the compound of claim 2 or the compound of claim 26, the claim should clearly set forth at least one additional component of the “composition”. (2) Claims 24 and 26 set forth the same subject matter. Claims 25 and 27 set forth the same subject matter. These claims are, therefore, duplicate claims and it is suggested that applicant cancel one set of claims. (3) Claims 16 and 18 recite a “coating” but fail to clearly recite that a substrate is present for the “coating” to be on. A film or sheet might be obtained by radiation curing the composition of claim 9 or claim 11, however, a “coating”, by definition, requires the presence of a substrate that the coating composition is cured upon to provide a coated substrate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, 9-21, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Nason et al (4,656,202). Nason et al disclose coating compositions comprising an acrylated cellulosic, an acrylated oligomer and a photoinitiator. The hydroxy groups in the cellulosic material are reacted with isocyanato acrylate to produce the acrylated cellulosic. See the formula in column 3, lines 1-11. The acrylated product anticipates a species of the compound of formula (I) in claim 2 wherein “A” is “P” derived from a cellulosic polymeric compound. Addition of a second polymer is taught in column 4. The examples teach solvent coating instead of powder coating. However, the recitation “powder paint composition” in the preamble in the instant claims is not considered to be sufficient to distinguish over the prior art disclosure. The acrylated cellulosic polymeric compound disclosed by Nason et al would be expected to provide a powder paint binder composition as instantly claimed since it corresponds to the required component set forth in the instant claims. With respect to claims 9, 10, 12 and 14-17, the polymeric oligomers disclosed by Nason et al in column 2 provide a crosslinked as set forth in claims 10 and 14 and would be expected to include species having the required amount of unsaturation (WPU) set forth in instant claims 9, 12, 13 and 15. Those compositions disclosed by Nason et al wherein the polymeric oligomer (second component) has the required amount of polymerizable unsaturation are considered to anticipate the instant claims.

***Response to Amendment***

The objection to the disclosure set forth in paper number 8 is withdrawn in response to the amendment to page 5 which clarifies the meaning of “WPU”.

The rejection of claims as being anticipated by Chevallier et al (5,360,836 or equivalent EP 0 263 749) is withdrawn in response to the amended claims. The rejection of claims as being anticipated by Kelley (3,366,613) is withdrawn in response to the amended claims. The rejection of claims as being anticipated by Kobayashi (4,910,268) is withdrawn in response to the amended claims. The compounds disclosed by Chevallier et al, Kelley and Kobayashi are excluded from the instant claims by the proviso for when n=1 set forth in instant claim 2.

*Response to Arguments*

Applicant's arguments filed 07-17-2002 have been fully considered but they are not persuasive with respect to Nason et al. Applicant argues that Nason et al do not disclose compounds having the structure set forth in instant claim 2 because the compounds disclosed contain urethane linkages. This argument is not persuasive because when the polymer "P" in the instant claims is a cellulosic polymer urethane linkages will result from reaction of hydroxyl groups with the isocyanate group. The disclosure of Nason et al teaches the reaction between hydroxyl groups in the cellulose polymer and a(meth)acrylated isocyanate that would be expected to provide a cellulosic polymer having cellulose-O-CONHROCOCR=CH<sub>2</sub> groups corresponding to the instantly claimed polymeric compounds.

*Allowable Subject Matter*

Claims 22, 23 and 25 or 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Berman whose telephone number is (703) 308-0040.

The fax number for this group is (703) 872-9310 or, for submissions after Final Rejection, (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist at telephone number (703) 308-0661.

*Susan Berman*

Susan Berman  
Primary Examiner  
Art Unit 1711

S B  
12/17/02